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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/840,467 | 04/24/2001 | Sung Lyong Lee | Q62056 | 1924 |

7590

04/21/2004

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WASHINGTON, DC 20037-3213

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| EXAMINER |
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ALPHONSE, FRITZ

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| ART UNIT | PAPER NUMBER |
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2675

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DATE MAILED: 04/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/840,467

Applicant(s)

LEE, SUNG LYONG

Examiner

Fritz Alphonse

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 19 March 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of copending Application No. 09/840,023. Although the conflicting claims are not identical, they are not patentably distinct from each other because: dependent claims 3-8 of the present Application are substantially similar to claims 3-9 of the copending Application; in addition, the present application does not teach about "OSD object unit".

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to replace "OSD object unit" as disclosed in the copending Application by "OSD multi cursor display data" in the present application. Doing so would not affect the good functionality of the OSD display apparatus.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Sato (U.S. Pat. No. 5,949,407).

As to claim 2, Sato discloses the following claimed subject matter, note:

- a) an OSD display apparatus, comprising an OSD source remote controller for generating an OSD cursor display command on a screen (this is met by the expansion key 24 of a remote controller 30, fig. 16, which controls an on screen cursor display command on a CRT; col. 9, lines 50-60);
- b) an OSD source for transmitting a plurality of OSD multi cursor display data by giving each OSD multi cursor display data a peculiar ID and transmitting a selected OSD multi cursor ID and display location information in the case that there is an OSD multi cursor display command from said OSD source remote controller (is met by windows with the cursor into which characters have been inputted and then by inputted the command codes by using the remote controller; col. 10, lines 52-61; col. 7, lines 30-40) ;and
- c) a display apparatus for storing the plurality of OSD multi cursor display data received from said OSD source in a memory and reading an OSD multi cursor display data having a corresponding ID from said memory (this is met by the remote control system which has a receiving area for receiving, storing and reading various command codes stored in the memory; col. 3, lines 10-38) and displaying the OSD multi cursor display data on a

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screen at a given display location in response to the received OSD multi cursor ID and display location information (see figure 57).

As to claim 1, method claim 1 corresponds to apparatus claim 2. Therefore, it is analyzed as previously discussed in claim 2 above.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 3-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sato in view of Morrison (U.S. Pat. No. 6,591,292).

As to claim 3, Sato does not explicitly disclose an MPEG source for supplying an MPEG transport stream to the display apparatus.

However, in the same field of endeavor, Morrison (figs. 1, 2) discloses an OSD image display apparatus, wherein the OSD source comprises: an MPEG source for supplying an MPEG transport stream to the display apparatus (which is met by the transport decoder 55, fig. 2); an OSD generator for generating OSD display data in bitmap format (note the generator 115, fig. 2); a register for storing data (is met by Smart Card 130, fig. 2); and a controller for controlling the MPEG source, the OSD generator, and the register, is met by system controller 115.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Sato with programming information device as disclosed by Morrison. Doing so would provide a convenient way of electronically

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linking program information with the contents of an electronic message when the electronic is sent and received.

As to claims 4, 7, Sato (figs. 2-4) show an OSD image display apparatus, wherein the OSD source further comprises: a command input part (note col. 2, lines 12-26, Sato teaches about command input means) for receiving a command signal from the OSD source remote controller (1) and providing the command signal to the controller (CPU; see figure 2b).

As to claim 5, Sato does not disclose an MPEG decoder for decoding an MPEG transport stream.

However, Morrison (fig. 2) show an OSD image display apparatus, wherein the display apparatus comprises: an MPEG decoder for decoding an MPEG transport stream and outputting image data (this is met by the Transport Decoder 55); a buffer (note the Packet Buffer 60) for buffering OSD data; an overlapper for overlapping the image data and the OSD data and providing overlapped data to the screen, is met by Application Interface 70, fig. 2; and a controller (29) for controlling the MPEG decoder, the buffer, the overlapper, the memory, and the screen, is met by system controller 115 (see figure 2).

As to claim 6, Sato (fig. 2) show an OSD image display apparatus, wherein the OSD image display apparatus further comprises: a display apparatus remote controller (2a).

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Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fritz Alphonse whose telephone number is (703) 308-8534.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Saras, can be reached at (703) 305-9720.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks


Washington, D.C. 20231

or faxed to:

(703) 872-9314 (for Technology Center 2600 only)


Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.


F. Alphonse

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April 8, 2004


STEVEN SARAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600